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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/552,911	06/09/2006	Roy Johannes Hofste		6901

30621 7590 11/22/2006

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SEATTLE, WA 98121

EXAMINER

MAZUMDAR, SONYA

ART UNIT	PAPER NUMBER
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1734

DATE MAILED: 11/22/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

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<b>Office Action Summary</b>	<b>Application No.</b> 10/552,911	<b>Applicant(s)</b> HOFSTE, ROY JOHANNES	
	<b>Examiner</b> Sonya Mazumdar	<b>Art Unit</b> 1734	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 13 October 2005.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-3 and 6-14 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3 and 6-14 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 13 October 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Priority*

1. It is noted that this application appears to claim subject matter disclosed in prior Application PCT/NL04/00243, filed April 13, 2004. A reference to the prior application must be inserted as the first sentence(s) of the specification of this application or in an application data sheet (37 CFR 1.76), if applicant intends to rely on the filing date of the prior application under 35 U.S.C. 119(e), 120, 121, or 365(c). See 37 CFR 1.78(a). For benefit claims under 35 U.S.C. 120, 121, or 365(c), the reference must include the relationship (i.e., continuation, divisional, or continuation-in-part) of all nonprovisional applications. If the application is a utility or plant application filed under 35 U.S.C. 111(a) on or after November 29, 2000, the specific reference to the prior application must be submitted during the pendency of the application and within the later of four months from the actual filing date of the application or sixteen months from the filing date of the prior application. If the application is a utility or plant application which entered the national stage from an international application filed on or after November 29, 2000, after compliance with 35 U.S.C. 371, the specific reference must be submitted during the pendency of the application and within the later of four months from the date on which the national stage commenced under 35 U.S.C. 371(b) or (f) or sixteen months from the filing date of the prior application. See 37 CFR 1.78(a)(2)(ii) and (a)(5)(ii). This time period is not extendable and a failure to submit the reference required by 35 U.S.C. 119(e) and/or 120, where applicable, within this time period is considered a waiver of any benefit of such prior application(s) under 35 U.S.C. 119(e), 120, 121 and 365(c). A benefit claim filed after the required time period may be accepted if it is

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accompanied by a grantable petition to accept an unintentionally delayed benefit claim under 35 U.S.C. 119(e), 120, 121 and 365(c). The petition must be accompanied by (1) the reference required by 35 U.S.C. 120 or 119(e) and 37 CFR 1.78(a)(2) or (a)(5) to the prior application (unless previously submitted), (2) a surcharge under 37 CFR 1.17(t), and (3) a statement that the entire delay between the date the claim was due under 37 CFR 1.78(a)(2) or (a)(5) and the date the claim was filed was unintentional. The Director may require additional information where there is a question whether the delay was unintentional. The petition should be addressed to: Mail Stop Petition, Commissioner for Patents, P.O. Box 1450, Alexandria, Virginia 22313-1450.

If the reference to the prior application was previously submitted within the time period set forth in 37 CFR 1.78(a), but not in the first sentence(s) of the specification or an application data sheet (ADS) as required by 37 CFR 1.78(a) (e.g., if the reference was submitted in an oath or declaration or the application transmittal letter), and the information concerning the benefit claim was recognized by the Office as shown by its inclusion on the first filing receipt, the petition under 37 CFR 1.78(a) and the surcharge under 37 CFR 1.17(t) are not required. Applicant is still required to submit the reference in compliance with 37 CFR 1.78(a) by filing an amendment to the first sentence(s) of the specification or an ADS. See MPEP § 201.11.

### ***Specification***

2. The disclosure is objected to because of the following informalities: on page 1, line 20, "a not inconsiderable part" should be changed to "an inconsiderable part".

Appropriate correction is required.

***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 1 through 8, 12, and 13 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 recites the limitation "the starting material" in line 3. There is insufficient antecedent basis for this limitation in the claim.

Claims 12 and 13 draw reference to claims 4 and 5, respectively, which are both cancelled claims. Therefore, the structure of building elements disclosed by claims 12 and 13 are considered indefinite.

***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
  2. Ascertaining the differences between the prior art and the claims at issue.
  3. Resolving the level of ordinary skill in the pertinent art.
  4. Considering objective evidence present in the application indicating obviousness or nonobviousness.
7. Claims 9, 10, 12, and 13 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Grenier (US 6,025,053).

Grenier teaches wood boards, where pieces of coniferous wood are provided and those pieces with a desired fiber density are selected. Pieces are then bonded side by side by finger jointing with wood glue, and are further bonded to other joined pieces to create a plurality of lamellae to form an extended wood board (abstract; column 4, lines 34-41; Figures 2a-2g).

Although a preservative heat treatment is not disclosed by Grenier, it is inherent that undesired parts, or parts with defects, are removed from the pieces initially provided and is further taught by Grenier (column 3, lines 33-38). However, if it is not inherent, it would have been obvious for one having ordinary skill in the art to do so to make a wood board of superior quality uniformly and use for structural purposes.

In the event any differences can be shown for the product of the product-by-process claims 9 and 10, as opposed to the product taught by Grenier, such differences would have been obvious to one of ordinary skill in the art as a routine modification of the product in the absence of a showing of unexpected results; see also *In re Thorpe*, 227 USPQ 964 (CAFC 1985).

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“When the prior art discloses a product which reasonably appears to be either identical with or only slightly different than a product claimed in a product-by-process claim, a rejection based alternatively on either section 102 or 103 of the statute is appropriate. As a practical matter, the Patent and Trademark Office is not equipped to manufacture products by the myriad of processes put before it and then obtain prior art products and make physical comparisons therewith. A lesser burden of proof is required to make out a case of prima facie obviousness for product-by-process claims because of their particular nature than when a product is claimed in the conventional fashion.” *In re Brown*, 59 CCPA 1063, 173 USPQ 685 (1972); *In re Fessmann*, 180 USPQ 324 (CCPA 1974).

With respect to claims 12 and 13, which draw reference to cancelled claims 4 and 5, respectively, the building structure is considered undefined regarding the specificity of the structure.

8. Claims 1 and 2 are rejected under 35 U.S.C. 103(a) as being unpatentable over Grenier in view of the admitted prior art.

Grenier teaches a method of manufacturing wood boards. Pieces of coniferous wood are provided and after inspecting the fiber density of the wood pieces, pieces with a desired fiber density are selected. Pieces are then bonded side by side by finger jointing with wood glue. The joined pieces are further bonded to create a plurality of lamellae to form an extended wood board (abstract; column 4, lines 34-41; Figures 2a-2g)

Grenier fails to specifically teach subjecting wood pieces to a preservative heat treatment as a method to remove undesired portions from the pieces. However, the

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admitted prior art teaches such heating methods are already known and are conventional in the art (page 1, lines 7-20).

It would have been obvious to Grenier to use such a method taught by the admitted prior art and would have been motivated to do so as an environmentally safe way to improve physicochemical properties of the wood, such as dimensional stability and durability.

9. Claims 3, 6, 7, and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Grenier in view of the admitted prior art, as applied to claims 1 and 2 above, and further in view of Versterlund et al. (US 6,284,090)

The teachings of claims 1 and 2 are as described above.

With respect to claims 3 and 6, Grenier does not teach using a specific glue to join wooden pieces. Vesterlund et al. teach producing gluing together two or more wooden member surfaces by using a conventional thermosetting resin system comprising a resin and a hardener component; polyvinyl acetate resins may be used as the resin component (column 1, lines 13-22).

It would have been obvious to Grenier to use a specific glue as Vesterlund et al. taught and would have been motivated to do so as an alternative adhesive used in gluing wooden surfaces.

With respect to claims 7 and 8, Grenier teaches using an appropriate wood glue to bond pieces of coniferous wood (column 4, lines 9-10 and lines 40-41), but does not teach using a specific type of glue. Vesterlund et al. teach producing gluing together two or more wooden member surfaces by using a conventional thermosetting resin system



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comprising a resin and a hardener component; polyvinyl acetate resins may be used as the resin component (column 1, lines 13-22).

It would have been obvious to Grenier to use a specific glue as Vesterlund et al. taught and would have been motivated to do so as an alternative adhesive used in gluing wooden surfaces, as is conventional in the art.

10. Claims 11 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Grenier in view of Vesterlund et al. (US 6,284,090)

Grenier teaches wood boards, where pieces of coniferous wood are provided and those pieces with a desired fiber density are selected. Pieces are then bonded side by side by finger jointing with wood glue, and are further bonded to other joined pieces to create a plurality of lamellae to form an extended wood board (abstract; column 4, lines 34-41; Figures 2a-2g).

Grenier does not teach using a specific glue to join wooden pieces. Vesterlund et al. teach producing gluing together two or more wooden member surfaces by using a conventional thermosetting resin system comprising a resin and a hardener component; polyvinyl acetate resins may be used as the resin component (column 1, lines 13-22).

It would have been obvious to Grenier to use a specific glue as Vesterlund et al. taught and would have been motivated to do so as an alternative adhesive used in gluing wooden surfaces.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sonya Mazumdar whose telephone number is (571) 272-6019. The examiner can normally be reached on 8AM-4:30PM.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christopher Fiorilla can be reached on (571) 272-1187. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



SM

  
CURTIS MAYES  
PRIMARY EXAMINER